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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/503,532	02/14/2000	William Y. Hall	blbv-24.759	6743

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EXAMINER	
JANVIER, JEAN D	

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/503,532	HALL, WILLIAM Y.
	Examiner	Art Unit
	Jean D Janvier	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *7/20/04*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,8-19 and 23-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3, 8-15, 16-19 and 23-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 07/20/04 has been entered.

Detailed Action

Specification

Status of the claims

Claims 1-3, 8-15, 16-19 and 23-30 are pending in the Instant Application and claims 5-7 and 20-22 are canceled.

Claim Objections

Claims 1, 11, 12, 14 and 27 are objected to because of the following informalities:

Concerning claim 1, "profile word" is read to include --profile data--. In examining the claim, the Examiner considers whether or not the structure of the prior art, as shown below, is

capable of performing the functions recited in the claim. Further, for examination purpose, the claim is broadly interpreted.

Concerning claim 14, in examining the claim, the Examiner considers whether or not the structure of the prior art, as shown below, is capable of performing the functions recited in the claim. Further, for examination purpose, the claim is broadly interpreted.

Concerning claim 11, the limitations recited therein are interpreted as --using the customer's registration information to form the customer's profile utilized to prepare targeted presentation or programming for the customer in accordance with the customer's profile--.

Concerning claims 12 and 27, the limitations "...wherein the customer makes modifications to the programming information during the commercial transaction..." are rather premature. In other words, critical elements are missing or omitted from the claim limitations. For examination purpose, the Examiner interprets the above limitations as --using the customer's transaction data to update the customer's profile--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-4, 8-14, 16, 18-19 and 23-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Terranova, US Patent 6,422,464B1.

As per claims 1, 3-4, 8-14, 16, 18-19 and 23-29, Terranova discloses a method of and a system for automatically providing customer preferences during a fueling operation (commercial transaction). The system includes a fuel dispenser with an audio/video customer interface having a display and audio system. Wireless communications electronics are associated with the dispenser and adapted to receive signals including indicia from remote communications units (such as transponders related to registered customers). A control system and memory are provided to receive an indicia or an ID from a remote communications unit and provide a customer with select information, predefined by the customer, at the customer interface. **The selected information is chosen by the customer and associated with the remote communications unit prior to the transaction**. Notably, the control system may include a dispenser controller, a central site controller, a control system associated with a remote network, or any combination thereof (See abstract).

The present system is adapted to personalize a fueling operation on an individual customer basis (customized transaction). During a transaction, an interrogator will interrogate a transponder or a customer's remote communication unit and receive customer **preferences or profile** for identification indicia, which will allow the dispenser or associated control system to access predefined customer preferences or profile associated with that transponder and customer **(identifying a customer through a transponder during a commercial transaction and retrieve the customer's preferences or profile in order to display targeted information or**

programming to the customer during the transaction). Typically, the preferences are determined early in the fueling or transaction operation. **The information may be accessed as a customer approaches a dispenser to enable the control system to provide the identified customer with a personalized or customized programming such as personalized greeting, pre-selected information such as news, traffic, weather, scores or stock reports, in addition to providing customer-selected or customized advertising, merchandising or entertainment presentations prior to being issued a transponder or during a registration process (Presenting a customized programming including news or advertising to the customer during a commercial transaction).** The customer may fill out an application or form, relating to the types of information, greetings and multimedia presentations he or she would be interested in receiving during a fueling operation. The customer-selected information will be entered into a database associated with the transponder ID or actually stored on the transponder in a format capable of instructing the dispenser or central control system to act accordingly during a transaction. Here, the customer's indicia include identification indicia and the select information is stored in the memory associated with the identification indicia of the remote communications unit or transponder. The control system is adapted to remotely and wirelessly access the selected information in the memory of the customer's transponder upon receipt of the identification indicia and provide the select information at the customer interface accordingly during the commercial transaction or fueling transaction. In another embodiment, the fuel control system may also be adapted to access the customer's select information, chosen during a registration process, **at a remote network based on the indicia received from the remote communications unit or transponder and provide the select information to the customer**

interface. Additionally, the select information may be stored on an audio/visual source adapted for playback of audio/visual material according to the pre-selected customer information. The select information may include news, entertainment, advertising and merchandising material. Furthermore, the customer may elect to receive an audible or visual greeting at or near the beginning of the transaction. **The fuel control system may further be adapted to allow a customer to modify the predefined selected information or programming during a transaction to receive different or additional information. Preferably, the customer interface will include a keypad and display for effecting such modification.**

Moreover, Terranova discloses a method for automatically providing customer preferences during a fueling operation. The method includes receiving indicia from a customer's remote communications unit, determining select types of information predefined by the customer using the indicia, accessing information defined by the select types of information, and providing the information to the customer during the transaction or fueling operation. The receiving step may further include receiving identification indicia for the remote communications unit and the accessing step may include accessing information according to the select types of information in database using the identification indicia. Notably, the information provided to the customer may be the indicia received from the transponder, such as a greeting, or the information may be selected or defined by the indicia received from the remote communications unit.

The system also provides an embodiment adapted to track the customer's transactions via a transponder throughout a number of fueling environments operatively associated with host network 94. The basic flow of transaction tracking is shown in FIG. 25 wherein a typical fueling operation begins (block 1400) by a transmission from the transponder of transponder

identification indicia to the dispenser 18 (block 1410). During the transaction, transaction information are received from the transponder and/or gathered by the dispenser and central control systems (blocks 1420 and 1430). The information received and gathered preferably includes information such as the type of transaction, the dollar amount per transaction, frequency of transactions, and the location of these transactions. The information gathered by the central control system 50 may be relayed to the host network or major oil company network 94 (block 1440). The information is updated and compiled at the host network (block 1450) to enable study of customer activities and transactions. This information is very valuable in presenting customized advertising and merchandising in the fueling environment to the identified customer. Once the information is compiled at the network 94, the process is ended (block 1460) (customer's transactions data are used to update the customer's profile data stored in a server database in order to present targeted advertising to the customer based on the updated profile). .

Moreover, the system monitors the customer's transactions not only to present targeted advertisements to the customer, but also to provide loyalty benefits to the customer. Indeed, loyalty benefits are provided to the customer based on the customer's current transaction, past transactions (purchase history), etc. The loyalty benefits may be stored in the memory of the customer's transponder, in the fuel controller database or in a host computer network database. Finally, the loyalty benefits may be redeemable during a current transaction or in subsequent transactions at a plurality of participating gas stations and transaction data associated with the redemption of the loyalty benefits are also monitored and used to update the customer's profile.

See col. 1: 43 to col. 2: 54; col. 40: 22-33; col. 36: 57 to col. 37: 11; col. 37: 41; col. 14: 44 to col. 18: 40.

Claims 1-2, 15, 16-17 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by McCall, US Patent 6,152, 591A.

As per claims **1-2, 15, 16-17 and 30,** McCall discloses a system comprising a fuel dispenser with an interactive graphics interface or customer interface. The system easily retrofits onto an existing conventional fuel dispenser, thereby making it convenient and cheaper to integrate the interactive graphics interface or customer interface into an established conventional fuel dispenser. The system allows a customer to interact with commercials associated with secondary products or non-fuel products or amenities and other information outputted on the customer interface in an effort to encourage the customer to purchase amenities (music, food, etc.) sold at a store while buying gas at the pump or fuel dispenser. If the customer or identified customer decides to purchase at least one secondary product among a plurality of product categories while conducting a gas transaction, a receipt 700 of fig. 7, depicting the items purchased during the transaction, will be printed at the fuel dispenser subsequent to receiving a credit card or cash payment and the customer can take the receipt to the store where the secondary product(s) bought and paid for at the fuel dispenser can be picked up. **Further, the system provides a manner in which to determine in real-time, during the transaction, whether or not it is time to reward the identified customer based on a plurality of criteria including frequency of purchase or past transactions (customer's profile) stored in central database 32 coupled to a central processor remotely located from a gas station POS where the customer is conducting a transaction (wirelessly transmitting customer's information**

between the remote database of the central processor and the gas station POS). The rewards (loyalty benefits) or the customer's specific rewards (loyalty benefits) are stored in central database 32 wirelessly linked to the fueling POS or fueling environment (fig. 6). In general, the customer's rewards are contingent upon past and current transactions and are associated with the purchase of fuel and/or non-fuel products. In addition, the customer's transaction, occurring at the fuel dispenser, including at least one secondary or non-fuel product is recorded in database 32 and used for determining future rewards for the customer and commercials that should be presented to the customer via the customer interface. Finally, transactions can be conducted, at the pump or gas station, via a credit/debit card **or in cash.** In short, upon completion of the OFFER REWARD subroutine of step 308, execution proceeds to step 310 where the central and remote database 32 is updated with the transaction information for the customer. As mentioned previously, such information is used not only to update the customer's profile stored in database 32, but also to determine future offerings, commercials and rewards to the customer (fig. 6).

(See abstract; figs 1-8; col. 7: 6 to col. 8: 3; col. 11: 33 to col. 12: 10; **col. 4: 12-31;col. 5: 44-54**; **col. 6: 14-21;**).

Response to Arguments

Applicant's arguments with respect to the claimed invention have been considered, but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 308-1113. Further, the following fax numbers can be used, if need be, by the Applicant(s):

After Final- 703-872-9327

Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325

JDJ

09/03/04

Jean D. Janvier

Patent Examiner

Art Unit 3622